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1 RECORD OF ORAL HEARING
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3 UNITED STATES PATENT AND TRADEMARK OFFICE
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6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8
9

10 *Ex parte* GEORGE HOSHI
11
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13 Appeal No. 2009-011943 and 2011-006302
14 Application No. 10/440308 and 08/720070
15 Technology Center 3600
16
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18 Oral Hearing Held: June 14, 2011
19
20

21 Before JOHN C. KERINS, MICHAEL W. O'NEIL, and
22 FRED A. SILVERBERG, *Administrative Patent Judges*.
23

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36 The above-entitled matter came on for hearing on Tuesday, June 14, 2011
37 commencing at 1:47 p.m., at the U.S. Patent and Trademark Office, 600
38 Dulany Street, Alexandria, Virginia, before Paula Lowery, Notary Public.
39

1 It looks like the other cases are moving the same way.

2 There's a different series of cases -- same inventor, or he has a co-inventor
3 on the other one -- different structure, same rejection.

4 So we'll try to -- if we can get through those rejections in the common area,
5 then I'll run through the claims. Although in the second case -- the parent
6 case -- we pretty much laid out the distinguishing features of the claims in
7 the Appeal Brief. I'll point those out to the Board.

8 JUDGE KERINS: I apologize if I'm confused. Are you referring to cases
9 other than the two that we currently have?

10 MR. BUSHNELL: Am I going to discuss the other cases?

11 JUDGE KERINS: Right.

12 MR. BUSHNELL: No, not unless the Board brings them up somehow.

13 JUDGE KERINS: No, we'd prefer not to.

14 MR. BUSHNELL: It's just odd that with this particular set there are actually
15 two Examiners, as opposed to other Examiners in the same argument. We
16 have the same obviousness-type rejection in every case. I'm seeing double-
17 patenting type rejection in every case.

18 Years ago there was Tony Knight. I think he's gone to OPLA.

19 MR. SILVERBERG: He's in the Office of Petitions.

20 MR. BUSHNELL: He was the SPE, and we got an interview while he was
21 there, and the case went to issue post haste. We're here, and I appreciate the
22 Board's patience.

23 What happened is early on there was a requirement under Rule 146 for
24 election of species. Now, we made an election, but this was lethargic art that
25 became briefly active back in the mid-'90s. It skipped a generation of

1 development, as near as I can tell.

2 There's a trademark case that went over to CFC for this gentleman and his
3 wife that they sent back based on the fact that the Assa Abloy never filed
4 their statement of use after six years because they never put it in use.

5 It looks like the whole industry leap-frogged a generation of technology.

6 Now, we mentioned, I think, in our various Briefs that we have double
7 patenting. On the co-pending case that we're hearing today, all the double
8 patenting rejections have been withdrawn.

9 JUDGE SILVERBERG: In one case. In the other case there's obvious-type
10 double patenting. 11943 -- there's obvious-type double patenting.

11 MR. BUSHNELL: Yes. At various times there's been two, maybe -- I don't
12 know, but at least two double-patenting rejections.

13 In this case the double-patenting rejection is based not on the parent of this
14 application, or the direct parent; but it's based on a co-pending application.
15 Both of them are divisionals.

16 Now, we have Section 121. The CFC recently in the Boehringer case put to
17 rest the idea of as a result of -- the Examiner is not arguing consonance here.
18 The two tests of whether 121 applied were consonance with the original
19 requirement for election of species, although in Boehringer there were 142
20 restrictions.

21 The second requirement was filed as a result of -- the parties argued and as a
22 result the court sent a rejected argument that 121 is inapplicable solely
23 because the 812 patent was issued from an application that was a divisional.
24 They said they felt repeatedly that the result of requirement applies to the
25 challenge patent as well as the reference patent. They recognize that their

1 holding in this case, Boehringer, had the effect -- the old holding had the
2 effect of obligating Boehringer to file one or more divisional publications if
3 he wanted patent protection for the amount of that subject matter.

4 What they held is that Boehringer didn't actually do that. He, instead, filed
5 two successive divisionals to different combinations of inventions identified
6 in the restriction. He had a restriction 142 requirement.

7 The court held a safe harbor is provided to protect an applicant for being
8 penalized for dividing an application.

9 121 is not concerned with overlap and non-elected inventions prosecuted
10 within any particular divisional applications, or how such applications are
11 filed.

12 Now, I've argued that in various iterations of the Appeal Briefs before
13 Boehringer issued. What it is, when you all retire and you come over to this
14 side of the table, you have an Applicant that has a limited budget. All of
15 them do. Even the big companies these days.

16 They've got a restriction requirement, and they've written their claims so
17 they cover as a genus many, many variations. If you remember the two
18 cases: Ethicon v. U.S. Surgical, there were two.

19 One of them was ours. I think the inventor had 100 and some figures, about
20 an equal number of claims. Ethicon, of course, is Johnson & Johnson. No
21 restriction there, but that Examiner resigned after issuing the case. A good
22 Examiner.

23 The situation there, as here, you've got a scheme of mix and match different
24 components. Nobody objected to that all the way through the various
25 Appeals.

1 So in Figure 1 you might have a part that can be interchanged with a part in
2 Figure 11, or whatever. There's utility because they're common schemes,
3 but it's not a single invention, and it's like going to the second floor of the
4 department store, in the women's department, where they have what they
5 call mix and match, and they all have utility.

6 So when we get a requirement for election of species based on different
7 figures -- and this is based on different figures -- it's very hard for the
8 Applicant to preserve the scheme of coverage that he originally drafted the
9 claims to.

10 As Morris Cliffman from here, he used to represent IBM, and used to teach
11 at G.W. said: the more time an attorney spends on a case, the smarter he
12 gets. So at a point he realized he really should have drafted the claim a little
13 different, and there are amendments to the claims.

14 The court, the CFC, recognized that in the Boehringer case. So what was
15 subjected to the restriction, based solely on the figures, not on any definition
16 of this invention versus that invention versus that, 121 allows the Applicant
17 flexibility in divisionals to alter his claim coverage. That's what they did in
18 Boehringer.

19 They only filed two. So far we've filed three divisionals. Even that is
20 prohibitively expensive.

21 It's kind of unfair to the applicants to read 121 to prohibit him from trying to
22 get as broad a coverage of his original scheme. He's already surrendered the
23 original scheme when he complied with the requirement for election of
24 species.

25 Second, it's also unfair to the Applicant to force him to do nothing more than

1 claim the identical figure because, apart from Figure 1, they easily might
2 have a different utility from a part from Figure 11 -- a different advantage.

3 JUDGE O'NEILL: But isn't it also unfair to the public to have the
4 Applicant, and potentially patentee, extend his monopoly beyond what the
5 statutory scheme allows?

6 MR. BUSHNELL: That would be unfair if the patent were a monopoly. To
7 use another example from G.W., the Bulova quartz crystal watch -- the
8 Accutron. It was covered to a fare the well. No one in the class held out
9 their hands. Where's the monopoly?

10 Monopoly is market share. It's unfair to the public -- in this industry there's
11 two lock companies. They own a lot of little lock companies, and there's a
12 couple of very small lock companies. One is Kabas, Switzerland. The other
13 is Assa Abloy. They're both controlled by a single individual as you go up
14 the chain. They know very well what's going on. They're immensely
15 wealthy.

16 This is a gentleman from southeastern Virginia on his own nickel with some
17 skill. He is a pioneering inventor. The primary reference in Column 2 gives
18 two full paragraphs to this Applicant's pioneering effort in this art.

19 So where's the unfairness? He has no monopoly. There's no monopoly. All
20 he has is his wits and patent applications. There's no unfairness. No patent
21 is anything more than perhaps a hunting license, if you can afford to buy the
22 gun and ammunition.

23 Be that as it may, no, there's no unfairness here. What's unfair is in this case
24 -- I'll conclude with 121. I think with Boehringer we have no double
25 patenting issue here. There is a divisional, there are co-pending divisionals,

1 but the lineage is the same. They came from the same application.

2 JUDGE SILVERBERG: Excuse me, Counsel, are you stating that, if you
3 have an election of species and you file a divisional, double patenting cannot
4 follow?

5 MR. BUSHNELL: Not based on the parent or the child against the parent,
6 no.

7 JUDGE SILVERBERG: Claims in comparison to each other -- you cannot
8 have double patenting on the parent and the child.

9 MR. BUSHNELL: No, you cannot.

10 JUDGE SILVERBERG: Okay, thank you.

11 MR. BUSHNELL: It would be extremely unfair.

12 JUDGE SILVERBERG: I mean by case law. I'm not talking about fairness,
13 unfairness. Does case law and statutes say you cannot have -- you're
14 precluded from having obvious-type double patenting, claims of a child
15 based on a parent, when there was an election of species in the parent?

16 MR. BUSHNELL: That's correct. That is the state of the law today.

17 JUDGE SILVERBERG: Thank you.

18 MR. BUSHNELL: That requirement has never been withdrawn in these
19 cases. For example, in the co-pending Appeal Claims 43, 44, 45 are still
20 withdrawn. Why can't we have a rejoinder? I don't know. We've asked for
21 it, but we haven't got it.

22 So the unfairness is we're squeezing the Applicant at the very beginning of
23 this process as he strives to acquire a monopoly, a market share. So we're
24 hindering him on that.

25 JUDGE O'NEILL: Counsel, I just see a provisional double patenting. I

1 don't see an obvious type double patenting rejection.

2 So I understand the Boehringer case had to deal with actual obvious-type
3 double patenting, and here we have something that's just provisional.

4 MR. BUSHNELL: Thank you. A comment in the Board's opinion would be
5 helpful, I think, to the SB and to me.

6 I believe you're right. I haven't checked that. Remember, we were writing
7 interminable number of Appeal Briefs, and we assumed, when we filed this
8 divisional, it would get to either issue or to the Board long before the co-
9 pending application based on our experience with this examiner.

10 But the Examiner's repeated the rejection here in her Brief, and we have to
11 address it. So we've done that.

12 I'm pretty sure -- sometimes the CFC does odd things, or says odd things
13 during oral argument. I'm very sure I could nip that in the bud during oral if
14 they ever raised that. They're flexible. You just have to tell them no that's
15 wrong because --

16 Now, going to the merits of the case, we have -- how am I doing? Ten
17 minutes?

18 JUDGE KERINS: I think we're 15.

19 MR. BUSHNELL: Okay.

20 JUDGE KERINS: I do know we have a few specific questions, if you'd like
21 us to do that first.

22 MR. BUSHNELL: Sure, go ahead. On double patenting?

23 JUDGE KERINS: No, on the R rejection.

24 JUDGE SILVERBERG: Let me make a statement and get your opinion. Is
25 it your opinion that the Examiner's conclusion of obviousness is based on the

1 substitution of one blocking mechanism for another blocking mechanism,
2 the miniaturization of the substituted blocking mechanism components, and
3 the mere reversal of parts?

4 MR. BUSHNELL: That is how the Examiner characterized that.

5 JUDGE SILVERBERG: And in regards to that, why do you feel that the
6 Examiner's rejection is fraught in making the simple substitution that KSR
7 permits the mere reversal of parts and also the miniaturization? If you can
8 elaborate, it would be appreciated.

9 MR. BUSHNELL: Let's take miniaturization first. I have no idea where
10 miniaturization came from. Gokceby doesn't talk about miniaturization.
11 Thordmark doesn't talk about miniaturization. We don't talk about
12 miniaturization.

13 In fact, Gokceby wants to replace --

14 JUDGE SILVERBERG: Naveda talks about a miniaturization of coils and
15 electronic components.

16 MR. BUSHNELL: Naveda, that's correct.

17 But look at Naveda. He talks about miniaturization, but he goes 180 degrees
18 -- the antithesis. Why? Our claims, our drawings describe an embodiment
19 with a single axis of rotation. So does Gokceby, and so does Thordmark.
20 One axis of rotation.

21 JUDGE SILVERBERG: Correct.

22 MR. BUSHNELL: Now, Naveda has to have three axes of parallel rotation.
23 That's what he describes.

24 JUDGE SILVERBERG: But the Examiner states that they're only relying
25 on Naveda for miniaturization. Not talking about any other aspects of it -- I

1 just would like you to present your argument.

2 If you look at Gokceby, it does have a miniaturized solenoid that's in there to
3 begin with -- inside the plug. So if you can address that.

4 MR. BUSHNELL: Okay, Naveda is actually using magnetic alignment.

5 JUDGE SILVERBERG: It teaches a miniaturized electronic component.

6 MR. BUSHNELL: Yeah, except that one thing. In the technology,
7 Gokceby is a cylinder lock.

8 JUDGE SILVERBERG: Right.

9 MR. BUSHNELL: It would be like this, okay?

10 Thordmark is actually, if you read it carefully, a night latch. He calls it a
11 latch. It's an override.

12 That technology is shown in the modern form of those, but it still existed a
13 hundred years ago.

14 Naveda is what's called a case lock. I don't know exactly where it goes, but
15 it looks like it goes on the inside of a door of the safe.

16 Now, Gokceby addresses that kind of thing. He addresses some of Hyatt's
17 work that in telephone lock boxes and other things where space is not a
18 problem. Gokceby makes a point he wants one-for-one space compatibility
19 with existing cylinder lock hardware.

20 Naveda doesn't observe that at all. He said miniaturization, but that's a
21 failed technology. What he's actually doing is looking for magnetic
22 alignment in his key in the core.

23 So we don't have miniaturization. We want the same thing as somebody like
24 Gokceby. We have some claims directed to retrofitting.

25 So I don't know why the Examiner brought up miniaturization. As far as I

1 know, nobody discussed that. I don't know where that came from, and we've
2 tried to explain that repeatedly.

3 That Naveda, one, may use the adjective miniaturization, but he sure doesn't
4 teach anything comparable. The case lock would be about this big, as
5 opposed to something this big.

6 JUDGE SILVERBERG: Isn't he espousing miniaturization to try to fit
7 components into the plug, rather than the surrounding --

8 MR. BUSHNELL: He perhaps did, except his plug is huge. It's not small.
9 A 2010 car key, 2003 -- they get bigger and bigger.

10 If you look at Assa Abloy and Kabas, they don't sell to you and I. They sell
11 under very strict control of individual units through their registered
12 locksmiths, and they're not small. I guess in a year or two, they're going to
13 start selling the whole door and the frame.

14 The days when you could buy a cylinder lock -- my kitchen door is Sergeant
15 S-1, and I've got it working real fine. It still works after -- 1922. It came out
16 -- I saw an advertisement -- in 1910.

17 If we're going to make this on the public retail, we want something
18 comparable in size. I don't know why miniaturization is here. It's a red
19 herring.

20 Other Examiners in this technology have never gone off on it.

21 JUDGE SILVERBERG: I think the Examiner's position was take Gokceby,
22 you've got Thordmark, we're going to substitute one blocking mechanism for
23 another.

24 When you substitute the blocking mechanism, we've got to get that blocking
25 mechanism that's outside in the cylinder into the plug. So now I'm going to

1 say mere reversal of parts.

2 But if I put them in there, in order to get it into the plug, we've got to shrink
3 them down in size so that the thing would not take up an extraordinary
4 amount of space. That's the Examiner's position.

5 The Examiner says we can substitute one for the other. Once we do that,
6 now we're going to reverse where the parts are located, and while they're in
7 the plug in order to make the plug usable, I'm not going to shrink them all in
8 size, and that's where the miniaturization came from.

9 Can you explain to us why that rationale is flawed?

10 MR. BUSHNELL: That rationale is flawed because Gokceby wants a
11 particular structure that works in a particular way. He's very specific about
12 that, and he also wants an independent. He wants a separate lock that's not
13 controlled with the pin tumblers or any other components of the locking
14 mechanisms.

15 These locks have two parts: the mechanical key part, and tumblers -- it's
16 well known, well developed -- and the electronics.

17 Now, if I jump the process, there's a plethora of cases that are patents on
18 electromechanical --

19 JUDGE SILVERBERG: We're only limited to the three before us right
20 now.

21 MR. BUSHNELL: No, each one of those has a plethora of references, and
22 we discuss --

23 JUDGE SILVERBERG: We're dealing with the rejection of Gokceby,
24 Thordmark and Naveda. Any extra references are not before us right now.

25 MR. BUSHNELL: They're in the Brief, and I discuss them, and they're of

1 record.

2 JUDGE SILVERBERG: But they weren't cited by the Examiner in the
3 office action.

4 MR. BUSHNELL: No, but we cited them to the Examiner under MPEP in
5 response to the rejections.

6 JUDGE SILVERBERG: They were in the Reply Briefs that were not
7 considered by the Examiner.

8 MR. BUSHNELL: In this case, but they're in the Brief in the other case, and
9 under MPEP 609.02 and under MPEP 2001.06(b) it's mandatory for the
10 Examiner to consider all those references.

11 JUDGE SILVERBERG: We're considering the rejection before us.

12 MR. BUSHNELL: Do consider the rejection before us, because under KSR,
13 Graham v. John Deere we got to have the state of the art. The state of the art
14 is exactly what the Examiner said. There are many, many, many, starting
15 with Smith --

16 JUDGE SILVERBERG: Might I ask that you tell us why the rejection is
17 flawed, as opposed to what the state of the art is. We are aware of the
18 technical problem. We're aware of the state of the art.

19 MR. BUSHNELL: Yes, the question is not miniaturization. The question is
20 miniaturization of what parts.

21 JUDGE SILVERBERG: What parts are you talking about now?

22 MR. BUSHNELL: Well, we've got D10 in some claims, we've got a bar in
23 other claims. We've got a stationary D10 or stationary bar.

24 JUDGE SILVERBERG: Has the Examiner addressed miniaturization of
25 those parts?

1 MR. BUSHNELL: No. The Examiner basically is arguing in the co-
2 pending case, and I guess in this -- wholesale substitution, her words.

3 JUDGE SILVERBERG: Right, it's one blocking mechanism for another.
4 Then --

5 MR. BUSHNELL: She wants to take the exterior part of --

6 JUDGE SILVERBERG: Right.

7 MR. BUSHNELL: -- Thordmark and put that in the primary reference.

8 JUDGE SILVERBERG: Correct.

9 MR. BUSHNELL: What she wants to do with that is ignore the fact that
10 some of these claims have relation, and others provide advantageously a
11 relation between the mechanical part of the lock and the part that she's going
12 to -- she doesn't have that.

13 JUDGE SILVERBERG: Do I understand your position that while the
14 substitution may be possible, that when you reverse the parts there's no
15 rationale for miniaturizing some of the parts?

16 MR. BUSHNELL: You want a lock that works. It doesn't make any
17 difference whether it's miniaturized or not as long as it works.

18 JUDGE SILVERBERG: Well, it could be like this?

19 MR. BUSHNELL: It might be.

20 JUDGE SILVERBERG: And you might have this key that you can't carry
21 around.

22 Naveda is relating to miniaturizing electrical components, so am I to
23 understand your position is that it doesn't teach miniaturizing, as you said
24 before, the D10 --

25 JUDGE KERINS: Structural components?

1 JUDGE SILVERBERG: Yeah, the structural components?

2 MR. BUSHNELL: He actually has no D10, he has some gear there.

3 JUDGE SILVERBERG: So it does not teach miniaturizing the other
4 components?

5 MR. BUSHNELL: He does not.

6 JUDGE SILVERBERG: Okay.

7 MR. BUSHNELL: For whatever reason -- well, you get over here, you'll
8 see. The inventor calls up 11:00 o'clock at night and says by the way, add
9 this. Other inventors will say where does the claim say this? The attorney
10 writes furiously and at 11:35 you head for the mail room to file it or do it
11 electronically.

12 JUDGE SILVERBERG: You can go through EFS now.

13 MR. BUSHNELL: But still somebody has got to do it.

14 JUDGE SILVERBERG: You've got to midnight.

15 MR. BUSHNELL: Somebody likes to go to baseball games --

16 JUDGE SILVERBERG: You're no longer going to the airport and putting
17 the thing in express mail.

18 MR. BUSHNELL: No, no, but my point is the attorney doesn't always get
19 everything the inventor may have in his head on the paper, and the attorney
20 was setting up the background for miniaturization, but who knows
21 miniaturization of what?

22 My point is, miniaturization is great, it's existed for a long time; but
23 miniaturized what? In combination with what? To get cooperation with
24 what other parts?

25 JUDGE SILVERBERG: May I ask another question? Assuming arguendo

1 the Examiner is correct, would it still work?

2 MR. BUSHNELL: Not really for the part of Thordmark. Thordmark talks
3 about axial tampering. You saw that paragraph, right?

4 What it is is people will take a punch, and they'll put it on the key face or
5 face plate. Then with a ball peen, they just gently tap it until they get the
6 D10 to shift a little bit.

7 Thordmark talks about precision of movement of the locking bar 10, I
8 believe. It might be 11, it might be 10.

9 JUDGE SILVERBERG: Right.

10 MR. BUSHNELL: This weekend for another case I was reading the
11 adjustment mechanisms for Brown & Sharpe for micrometers. They have
12 very similar screwed structure as Thordmark, and they make the point they
13 wear and they have to be adjusted. That's what the tampering is.

14 So the axial positioning is problematical in the real world, but why he
15 focused on that, I don't know.

16 This is Assa Abloy, a very big company. They file sometimes on concepts,
17 as opposed to marketable hardware; but I think you'll see their later versions,
18 or actual market versions, depend on temporary deformation of parts to
19 defeat tampering, not something that looks very much like a micrometer
20 from Brown & Sharp. Brown & Sharpe admits that after a while it has too
21 much play in the screw or the solenoid.

22 JUDGE SILVERBERG: So your position is even if you did reverse the
23 parts and somehow put the mechanism of Thordmark into Gokceby and put
24 it into the plug, it still wouldn't work as intended.

25 MR. BUSHNELL: No, it wouldn't work in the way that Gokceby wants.

1 Gokceby, by the way, is a real, breathing person. I've never met him. I only
2 get secondhand what he says and does.

3 For whatever reason Gokceby went off in a different direction after that
4 patent, if you look at his later work. I've never actually had the chance to
5 talk with him.

6 Let me see if I can find Gokceby -- both Gokceby and Thordmark want
7 something that they say -- Thordmark says "mutually independent."

8 Gokceby says "separate," I believe. They want separately operable.

9 In some of the Applicant's claims, you'll see there's a time sequence where a
10 torque is applied to a key, or when a data signal is transmitted by the key to
11 the lock cylinder -- cylinder plug, I'm sorry. That is not present in either of
12 these.

13 In fact, Thordmark talks about transmitting from the key to an antenna.

14 Now, why is that? Thordmark, as I told you, is a night latch.

15 In older houses you have a cylinder lock, and it's a case lock, actually, on the
16 back of the door. Some of them have a little button that you push up at night
17 so somebody on the outside cannot unlock the door with a key. That's what
18 Thordmark is. It's an override.

19 Now, why does he want that? If any of you have been in a hotel lately, they
20 have various kinds of pass keys, but that's not a guarantee you can open the
21 door.

22 What they have in a hotel -- miniaturization or not -- they've got the whole
23 door and whole door frame. One thing you'll notice in the early claims of
24 this Applicant was -- and in Gokceby -- the electrodes, or the wires for
25 conducting the signal, that was important, or thought to be important, at the

1 time of the invention.

2 In the hotel locks, who cares? You've got the whole door frame, the whole
3 wall. They come from downstairs, central control.

4 Now, in the Applicant you can't do that.

5 Thordmark doesn't tell you how he gets his electrical signal to his
6 miniaturized night latch or his latching mechanism. Well, it comes through
7 the wall because it's a hotel-type lock.

8 Now, the origin for that kind of technology, using the electromechanical was
9 General Motors, as near as I can tell. I think it was a Smith patent years ago.

10 It's not from the key -- they give you a plain key. It comes from your car
11 battery, and it runs through the firewall and into the door. Space is not a
12 problem, and the solenoid is on the outside.

13 All the references we filed citing or rebutting the Examiner's argument about
14 interchangeable Thordmark and obvious reversal cite that well known art.

15 That it's well known to have an external electromagnet to the outside of the
16 cylinder -- the housing itself. That's why Thordmark doesn't do that.

17 Gokceby does describe how he gets his signals in there. We describe pretty
18 much a similar structure. What we don't do, and what we didn't want to do,
19 is have a separate mechanism.

20 We wanted a hierarchical system so you can have different levels of access.

21 We wanted that with a retrofittable cylinder plug. Unlike Gokceby we don't
22 have to drill a hole or make any change.

23 One of our claims in this case talks about putting the side bar, latch, or D10,
24 in the existing groove or whatever. So that's much different than

25 Thordmark.

1 JUDGE KERINS: If I may go back to the overall combination, it seems to
2 me if we're shrinking the size of some of these structural components just to
3 fit them into the plug, do we retain the strength that we need in order to
4 prevent tampering and things like that? Is that a consideration?

5 MR. BUSHNELL: No, we definitely do not. Just to give you an example,
6 the U.S. Air Force during the big war -- '66, '67, I got sucked in -- did a
7 survey how long does it take to break each type of lock? What's the mean
8 time? How hard is it? They knew so many hours.

9 When I was about ten I acquired a key that would open those laminated
10 master locks. The one that had the zigzag key retainer? About the time I
11 was 18 it dawned on me it was not smart to have that, but it opened every
12 one. In all those years Master sold those.

13 What we're selling here -- what lock makers sell -- is reliability and
14 confidence. Some sell nothing more than chrome polish, but these people
15 spent a lot of time to make sure it's
16 foolproof.

17 When you miniaturize parts like that without grave effort in determining
18 how they're going to be inserted, it's just a paper patent.

19 In my experience -- 36 years -- inventors are very particular about what they
20 claim. I've had inventors tell me that's a beautiful claim, but that's not my
21 invention. Well, we've got to rewrite. It's too broad, or it's whatever.

22 Inventors do not file on subject matter that they don't think they can make.
23 They just won't do it.

24 JUDGE KERINS: A person of ordinary skill in the art is not likely to look
25 at this and think we can -- particularly, the structural components of say

1 Thordmark -- think we can shrink this down, put it in the plug, and it'll work.

2 MR. BUSHNELL: No, they already have miniature -- look at model
3 railroading equipment. They've got miniaturization for how many decades.

4 But what you do with that miniaturization, where do you put it?

5 What you've got here is a pioneering inventor, actually two -- you've got
6 Gokceby and he recognizes Hyatt in his background in Column 2. It took
7 him a long time to get the idea of taking the solenoid or the motor from the
8 outside and putting it in the inside.

9 Why is that? Different inventor, different technology, very experienced
10 primary, the interview wasn't going well. I said can I have another interview
11 if I bring the inventor? Sure. Do you need to expand your search? Why
12 should I? I know everything this fellow did. He's the best in the world.

13 Second interview, the only question is: Mr. Inventor, why can't we take this
14 electrode from second patent and this screen from the third patent and
15 reverse them?

16 The inventor's answer was: I ask myself every morning why did it take me
17 four years to appreciate that? Why couldn't I have done that four years ago?
18 That's invention.

19 The primary gave him his patent.

20 Now, here Gokceby is a non-elected species. Remember Gokceby is our
21 Applicant's Figure 8-H. That's what we got in there in the Hyatt 601. For
22 some reason, even though it's a non-elected species, they put that on the OG
23 page.

24 I guess ostensibly in the story the Examiner said our Figure 8-H is
25 patentably distinct and independent of everything else.

1 Where's my summary -- is there any particular claims? They're all different.

2 JUDGE KERINS: I think we're looking mostly at the overall combination.

3 MR. BUSHNELL: Okay.

4 MR. O'NEILL: I have some questions basically on the overall combination
5 based on my review of your Briefs. It came to me, if I understand your
6 position -- we understand in the realm of obviousness the Graham factors,
7 and KSR as KSR reiterated or reaffirmed Graham.

8 I'm understanding one of your positions is the Examiner really hasn't shown
9 any of the elements of the claimed invention. Let me explain that.

10 In the KSR case, as I recall, it was basically all the elements were just off-
11 the-shelf components from different patents. The court decided that would
12 be obvious to one of ordinary skill in the art to take all these off-the-shelf
13 components.

14 In other words, one patent showed a couple of elements, another patent
15 showed a couple of the other elements. But here what I'm understanding in
16 your Briefs and this argument, the Examiner's rejection -- the Examiner
17 hasn't set forth any of your elements. Basically, just look at everything, and
18 it's obvious. I'm going to take and miniaturize something, I'm going to
19 reverse parts, I'm going to do this, and I'll come up with your elements.

20 But none of these references actually have any of your elements, is that fair?

21 MR. BUSHNELL: That's correct.

22 MR. O'NEILL: Okay, that's one thing I've gotten out of this.

23 My second thing I've gotten out of this is it seems that the Examiner's
24 rejection seems to be based on after an extensive review of your
25 specification essentially the Examiner, with your specification in mind

1 looking at your claims, going out and finding pieces of art that might fit
2 within your disclosure and might fit within what you're claiming. It's almost
3 like a hindsight position that the Examiner has utilized.

4 MR. BUSHNELL: That was worrisome to us. We've had interviews with
5 the Examiner and suggested expanding the scope of the search because we
6 cannot go against Assa Abloy or Kabas with invalid claims.

7 Yes, that was extremely worrisome to us.

8 JUDGE O'NEILL: On page 49 of your Appeal Brief in the Serial No.
9 10/440308, I was under -- maybe I have that one wrong. I was under the
10 impression that you're basically saying the Examiner has used improper
11 hindsight here or hindsight reconstruction given the evidence set before you.

12 MR. BUSHNELL: Yes, that's what we're arguing, yes.

13 JUDGE O'NEILL: Okay.

14 MR. BUSHNELL: Second, the Examiners before or pre In re: Gordon,
15 which was I think a 1984 case from the CFC -- federal circuit -- was a filter
16 of some kind. Blood filter I believe.

17 JUDGE O'NEILL: Turning it upside down?

18 MR. BUSHNELL: Yes. The real issue here is why did it take the art,
19 admittedly a lethargic art, this many years to put the electronics inside? I
20 submit they weren't interested in putting electronics inside. They wanted
21 them hard wired to the cash register or some other place. So they followed
22 General Motors' lead, and they've always put it on the outside.

23 JUDGE O'NEILL: I think how I'm hearing your position, Counsel, is
24 basically how you succinctly say it on page 49 of your Brief in the Series
25 10/440308. The Examiner's proposed combination, as well as the evidence

1 that the Examiner has provided, is simply using the Applicant's claim as a
2 blueprint in an impermissible effort to make a hindsight reconstruction of the
3 art.

4 MR. BUSHNELL: Yes.

5 JUDGE O'NEILL: That's how I hear it.

6 MR. BUSHNELL: That's our position.

7 JUDGE KERINS: Judge Silverberg, any other questions?

8 JUDGE SILVERBERG: No.

9 JUDGE KERINS: If you'd like to summarize very briefly.

10 MR. BUSHNELL: Probably one of the very few cases I ever bothered to
11 prepare a summary, but yes.

12 Naveda 127 adds nothing to the combination except miniaturization, so does
13 an extreme amount of other technology.

14 Miniaturization is not really a criteria here. Customers buy confidence,
15 reliability, repeatability. My kitchen door almost a hundred years of
16 continuous use.

17 Gokceby is interested in the lock that's easily retrofittable. That's Column 2,
18 Line 50. A lock that requires no additional space, Column 4, Line 41; and a
19 lock that provides secondary locking in Column 6, Line 51. He explains
20 exactly why that's crucial to his invention.

21 Now, he uses a solenoid and we've explained in here a solenoid at most, if
22 we recall our high school physics, has a coil, a winding. It's got an armature
23 that moves in response to the direct current through the coil, and it may or
24 may not have a spring.

25 I submit that Gokceby has a spring.

1 The Examiner kind of waffles between the armature and the D10. Of course
2 we would have an armature, but in various of these claims we're covering
3 not just an armature that reciprocates like Thordmark, we're claiming we've
4 got a head that's stylized so it could give you different functions.

5 For instance, in one of them you can slam the door closed, and it engages the
6 solenoid head. In other it has step rotation and that sort of thing. Which one
7 will be popular in the market? We don't know.

8 Now, Thordmark's interested in a lock that provides mutually independent
9 latching. He says it's a latch, or blocking
10 devices -- that's Column 2, Line 67 -- and has two mutually independent
11 lock functions, Column 3, Line 9.

12 A lock that is insensitive to heavy vibrations. That requires a certain degree
13 of mass. Miniaturization is kind of the antithesis of that because you have
14 people like me, or children like me, that enjoyed opening locks.

15 I don't know why, but I did. These days I either cut them or drill them if I
16 can't find the key. I don't fool with it. But in those days -- heavy vibrations
17 will do it, that's Column 3, Line 63; Column 4, Lines 2 and 3; Column 4,
18 Lines 15-17.

19 Thordmark wants insensitivity attained through axial movement of the
20 blocking element, Column 6, Lines 22-24, with a block element having an
21 axial length greater than one-half -- that magic word one-half.

22 In re: Fry or somebody inveigled the Commissioner to actually write a
23 decision from the Board, and I think it was a sneaker and there was a one-
24 half limitation in there.

25 Thordmark wants something greater than one-half the axial length of the

1 cylinder plug. That argues against miniaturization.

2 Gokceby and Thordmark are both consistent in desiring either a secondary
3 locking mechanism or two or more mutually independent locking
4 mechanisms.

5 What that means is in the primary reference, as well as in Thordmark, they
6 have no cooperation with what's called a side bar, D10 or elongated bar. In
7 fact, Thordmark shows a separate side bar from his latching mechanisms 10
8 and 11. Why?

9 When would it occur to somebody reading Thordmark, hey, you can
10 combine these? Gokceby doesn't want to combine them. In fact, in his
11 lifetime he went in a different direction.

12 So the Applicant combined them or at least provided structure that
13 advantageously enables them to be combined. Axial movement is inimitable
14 to the expressed desire of Gokceby to assure retrofittable structure with no
15 requirement for additional space. Only if the mutually independent locking
16 mechanism of Thordmark is removed from the cylinder shell, as is
17 illustrated in Figures 3, 4, 5, 6 and 7, and instead is moved as a single unit.
18 That would be unsuitable for Gokceby because he wants his armature to
19 directly engage the shell. We interpose structure between that armature, and
20 we get the cooperation.

21 Idle process -- there used to be a member of the Board that was known as
22 Mr. Stoner. He's gone on, but there was a case in 1976, April I believe.

23 Yancy Williams was the inventor, Grand Central Station, New York, New
24 York for a bar of religious soap.

25 JUDGE SILVERBERG: Right.

1 MR. BUSHNELL: We had a case much later with a bar of soap. The
2 Examiner was young and very uncomfortable, but bless his heart between us
3 we found nine references identical except at the very point of novelty. The
4 inventor knew that. It was a lady.

5 What it is, you put a bottle cap in a bar of soap, suspended from a magnet.
6 We had limitations in the claims that distinguished the width, and we argued
7 idle process.

8 Months and months, maybe a year after oral argument, we got a written
9 decision reversing the final. It was signed by Mr. Stoner. I've never met
10 Mr. Stoner, but I'm very sure he didn't sit on the Appeal. I can give you a
11 copy.

12 He didn't mention idle process, but he did address the argument that I've
13 tried to weasel in here that Thordmark is just one of a cast of millions of
14 external locking mechanisms.

15 This is Mr. Stoner's opinion.

16 JUDGE KERINS: I don't believe it will be necessary.

17 MR. BUSHNELL: She passed on recently, and her husband paid the second
18 maintenance fee. I was very surprised. That's how idle process plays out
19 here.

20 JUDGE SILVERBERG: May I ask you one more quick question, if I may?

21 MR. BUSHNELL: Yes, sir.

22 JUDGE SILVERBERG: Are you telling us that the Series 10/44308 is an
23 election of species of the 6302 case? It was an election of species in the
24 prior application that you elected species E for Figures 8A through 8G, and
25 is this application -- the 11943 application -- a species non-elected in the

1 parent application?

2 MR. BUSHNELL: The first case, 10/440308.

3 JUDGE SILVERBERG: That's the child case.

4 MR. BUSHNELL: Yes.

5 JUDGE SILVERBERG: Is that a species or not?

6 MR. BUSHNELL: Actually --

7 JUDGE SILVERBERG: Is it or isn't it? If it has overlapping claims and it's
8 not a species, it's one answer. Is it a species of the prior case?

9 MR. BUSHNELL: It's a copy of a patent that was later filed -- junior patent
10 -- by Medico.

11 JUDGE SILVERBERG: But as a result -- so it's not a species of the prior
12 application?

13 MR. BUSHNELL: Yes, it is a species of the prior --

14 JUDGE SILVERBERG: That was non-elected?

15 MR. BUSHNELL: In the patent it's non-elected, yes.

16 JUDGE SILVERBERG: So the 08/72007, which is the application that
17 comprises the 2011006302, that's the other application before
18 us --

19 MR. BUSHNELL: Okay.

20 JUDGE SILVERBERG: That's the parent application?

21 MR. BUSHNELL: No, it's not.

22 JUDGE SILVERBERG: That's not the parent?

23 MR. BUSHNELL: No. Well, the actual parent -- the other case before you
24 is 08/720070.

25 JUDGE SILVERBERG: Right.

1 MR. BUSHNELL: Three divisionals were filed. One issued as U.S.
2 6564601.

3 JUDGE SILVERBERG: Right.

4 MR. BUSHNELL: And this ostensibly is a continuation of that that we filed
5 to bring attention to the Commissioner -- and we wrote letters --

6 JUDGE SILVERBERG: The question I've asked is: the application that
7 makes up our Appeal Number 2009/0011943 -- the 10/440308 -- is that a
8 species?

9 MR. BUSHNELL: Yes, that would be one species.

10 JUDGE SILVERBERG: Non-elected. That's not encompassing figures 8A
11 through 8G?

12 MR. BUSHNELL: Let's see --

13 JUDGE SILVERBERG: You elected in December of '97, Species E in
14 Figures 8A through 8G. You have stated to us here that 121 when you have
15 an election of species precludes double patenting if there was an election
16 made and a divisional application filed off of that application. Because once
17 you have a restriction, you cannot have double patenting.

18 So the question -- you have also stated this 10/44308 was a patent that was
19 copied of something else --

20 MR. BUSHNELL: Claim 6 was.

21 JUDGE SILVERBERG: -- to bring attention to this office. So I ask,
22 regardless of it being copied, was it filed as a species that was non-elected,
23 or does it have overlapping claims and it's not really a species in toto?

24 MR. BUSHNELL: Okay, it would --

25 JUDGE SILVERBERG: Because 121 precludes obvious-type double

1 patenting if a restriction is filed, election of species, and you elect Figures
2 8A through G, then you filed this onto your 12. You can't have double
3 patenting because we required the restriction.

4 MR. BUSHNELL: Yes, okay, to that extent and remembering what I said,
5 this was election of species based upon numbers of figures, Figure 1, Figure
6 2, whatever. In each figure you've got more than one concept.

7 JUDGE SILVERBERG: But if this also reads on Figure 8A that you elected
8 in the other one, then it's not a species.

9 MR. BUSHNELL: Figure 8A has more than one invention.

10 JUDGE SILVERBERG: But you elected 8A through -- you're telling me
11 there could be some overlap?

12 MR. BUSHNELL: Yes, there could be overlap.

13 JUDGE SILVERBERG: Okay. Thank you.

14 MR. BUSHNELL: Just to give you an example, with the same primary that
15 gave us the E patent, there's a creamer in the grocery store with a red or blue
16 lid that pops open. That was Tony Knight -- two patents. Two completely
17 unrelated inventions. One structure. One figure. Tony Knight.

18 JUDGE SILVERBERG: Okay.

19 MR. BUSHNELL: What we've got here in Figure 8A -- for example, if you
20 look at the side bar, it has little feet on it, unlike Thordmark's side bar. His
21 feet are the other way.

22 It's working in a different direction than the solenoid. It's not coaxial as
23 would be in the case with Gokceby and Thordmark. Different invention.

24 So if we make an election and we have the claims pending, are we supposed
25 to go back and amend the elected claims to make picture claims on the

1 elected drawing? No.

2 JUDGE SILVERBERG: All I was asking the question for was to clarify on
3 the record.

4 MR. BUSHNELL: Thank you.

5 JUDGE SILVERBERG: That's all I was trying to do -- it's not anything
6 other than clarify that it is not in toto that there was a restriction made in the
7 parent. The 440308 application is not in toto a species non-elected in the
8 parent application.

9 MR. BUSHNELL: I think that would be a fair characterization.

10 JUDGE SILVERBERG: Okay.

11 MR. BUSHNELL: It's basically what the court recognized.

12 JUDGE SILVERBERG: That's fine. I just wanted the record to be clear,
13 that's all.

14 MR. BUSHNELL: Thank you.

15 JUDGE KERINS: Thank you very much, Mr. Bushnell.

16 MR. BUSHNELL: I'm sorry I exceeded the time.

17 JUDGE KERINS: That's okay, thank you for your time.

18 (Whereupon, the proceedings at 2:49 p.m. were concluded.)

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